

Serial No.: 10/556,645
Group Art Unit No.: 1623

REMARKS

Upon entry of this amendment claims 1-5, 7, 8, and 12-14 will be pending in this application. Claims 10 and 11 were canceled in a previous amendment. Claim 6 and 9 are canceled without prejudice. Applicants reserve the right to pursue the canceled subject matter in a continuing application. Claims 1-5, 7, 8, and 12-14 are amended.

Claims 1 and 14 are amended to conform to proper Markush form.

Claims 1, 7, 8, and 14 are amended without prejudice to replace pharmaceutically acceptable derivatives with pharmaceutically acceptable salts.

Claims 2-5, 12 and 13 are amended to include pharmaceutically acceptable salts. Support for this amendment can be found on page 8, lines 14-16 of the specification.

Claim 8 is amended to remove the phrase “converting one compound of formula (I) into another compound of formula (I)” and replacing it with the phrase “oxidizing a compound of formula (I) wherein U or B is $-S(O)_z$ and wherein z is 0 to provide a compound of formula (I) wherein U or B is $-S(O)_z$ and z is 1 or 2”. Support for this amendment can be found on page 30, lines 14-16 of the specification.

Claim 12 is amended, without prejudice, to replace the term “microbial” with the term “bacterial”. Applicants reserve the right to pursue the canceled subject matter in a continuing application.

Applicants’ response to the Examiner’s Office Action is as follows.

Claim Objections

The Examiner has objected to claim 9 under 37 CFR 1.75(c) as being of improper dependent form for failing to limit the subject matter of the previous claim. Applicants have canceled claim 9 thus rendering the rejection moot.

Claim Rejections under 35 U.S.C. §112, first paragraph

The Examiner has rejected claims 9 and 12 under 35 U.S.C §112, first paragraph, because the specification, while being enabling for the treatment of bacterial infections, allegedly does not reasonably provide enablement for the prophylaxis or treatment of microbial infections.

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Applicants believe that the claims as filed are enabled. However, solely in order to expedite prosecution of this application and without in any way conceding to the propriety of the rejection, Applicants have amended claim 12 by replacing the term microbial with the term bacterial. Applicants respectfully request that the rejection be reconsidered and withdrawn.

Claim Rejections under 35 U.S.C. §112, second paragraph

The Examiner has rejected claims 1-9 and 12-14 under 35 U.S.C. §112, second paragraph allegedly as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the Examiner the terminology “a pharmaceutically acceptable derivative thereof” (claims 1, 6-8, and 14) render the claims indefinite, allegedly because it is not clear what is encompassed by said terminology. Applicants believe the claims as filed are clear. However, solely in order to expedite prosecution of this application and without in any way conceding to the propriety of the rejection, Applicants have amended the claims and removed the terminology “a pharmaceutically acceptable derivative thereof”.

The Examiner has rejected claim 6, stating that it is improper in that it depends from Examples 1-42. Applicants have canceled claim 6, thus rendering the rejection moot.

The Examiner has rejected claim 8, stating that it is not clear what is encompassed by the terminology “converting one compound of formula (I) into another compound of formula (I)”. Applicants believe the claims as filed are clear. However, solely in order to expedite prosecution of this application and without in any way conceding to the propriety of the rejection, Applicants have amended the claims and removed the terminology given above.

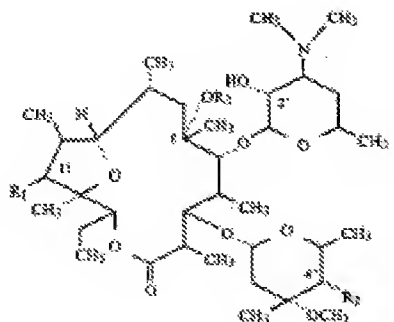
In light of the above amendments and remarks, Applicants respectfully request that the rejection of claims 1-9 and 12-14 under 35 U.S.C. §112, second paragraph be reconsidered and withdrawn.

Claim Rejections under 35 U.S.C §102(b)

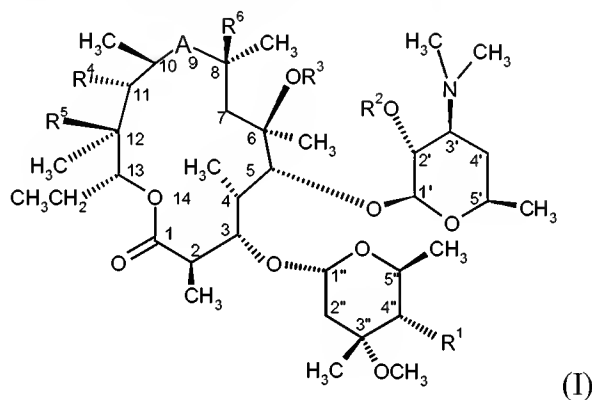
The Examiner has rejected claims 1-7, 9 and 12-14 as being anticipated by Freiberg *et al.* (US 5,288,709). Applicants respectfully traverse this rejection.

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Applicants submit that the instant claims are not anticipated by Freiberg. Freiberg teaches compounds of the following formula.



The instant claims are directed to compounds of formula (I).



When comparing formula (I) of the instant claims with the formula of Freiberg one can see that the two formulas are different. In Freiberg, an oxygen atom joins carbon 9 and carbon 12 together. In the instant claims, position 9 (variable A) is not joined to carbon 12. In light of this difference, the instant claims are not anticipated by Freiberg. Applicants respectfully request that the rejection be reconsidered and withdrawn.

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Conclusion

This reply is intended to further this case to allowance by addressing each ground of objection and rejection in the Examiner's Office Action. Reconsideration of this application is respectfully requested. Authorization is hereby granted to charge any fees which may be required by this paper to Deposit Account No. 19-2570. Should the Examiner have any questions regarding this application, the Examiner is invited to call the undersigned agent at the number given below.

Respectfully submitted,

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